

2875

Attorney's Docket No.: C1104/7061

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alfred D. Ducharme, et al.
Serial No.: 09/716,819
Confirm. No.: 9031
Filed: November 20, 2000
For: SYSTEMS AND METHODS FOR GENERATING AND
MODULATING ILLUMINATION CONDITIONS
Examiner: Lee, Y. My Quach
Art Unit: 2875

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 27th day of October, 2003.


Jeanne W. Chub

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following documents:

- ☒ Information Disclosure Statement, Form PTO-1449 and Cited References
- ☒ Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch are respectfully requested to contact the undersigned at (617) 395-7000, Cambridge, Massachusetts.

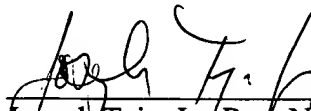
A check in the amount of \$180.00 is enclosed. If a fee is insufficient, the Commissioner is hereby authorized to charge the balance to Deposit Account No. 50/2762. A duplicate of this sheet is enclosed.

10/30/2003 CNGUYEN 00000110 09716819

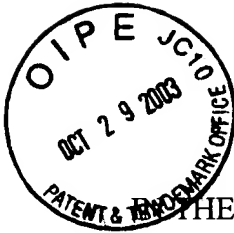
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Respectfully submitted,
Alfred D. Ducharme, et al., Applicants


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Attorney for Applicants

Dated: October 27, 2003



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Jeanne W. Chub

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**STATEMENT FILED PURSUANT TO THE DUTY OF
DISCLOSURE UNDER 37 CFR §§1.56, 1.97 AND 1.98**

Sir/Madam:

Pursuant to the duty of disclosure under 37 C.F.R. §§1.56, 1.97 and 1.98, the Applicant requests consideration of this Information Disclosure Statement.

PART I: Compliance with 37 C.F.R. §1.97

This Information Disclosure Statement has been filed more than three months after the filing date of this application and after the mailing date of the first Office Action, but before the mailing date of either a final action under 37 C.F.R. §1.113 or a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in this application.

The fee of \$180.00 as set forth in 37 C.F.R. §1.17(p) is enclosed.

PART II: Information Cited

The Applicants hereby make of record in the above-identified application the information listed on the attached form PTO-1449 (modified). The order of presentation of the references should not be construed as an indication of the importance of the references.

The Applicants also wish to bring to the attention of the Examiner the following information:

Pursuant to MPEP §2001.06(c), Applicants bring to the Examiner's attention that two U.S. patents currently assigned to the same assignee of the present application (i.e., Color Kinetics, Inc.) have been involved in litigation. These patents include U.S. Patent No. 6,016,038 (U.S. Serial No. 08/920,156) and U.S. Patent No. 6,150,774 (U.S. Serial No. 09/425,770), both assigned to Color Kinetics, Inc. The present application also incorporates by reference the entirety of U.S. Serial No. 08/920,156.

The aforementioned patents both are involved in the following litigations: Case No. 6:02-cv-270-ORL-19JGG in the United States District Court, Middle District of Florida, Orlando Division, and Case No. 02 CV 11137MEL in the United States District Court, District of Massachusetts.

Applicants acknowledge the duty to disclose to the U.S. Patent Office material information that may arise from these litigations, including evidence of possible prior public use or sales, questions of inventorship, prior art, allegations of "fraud," "inequitable conduct," and "violation of duty of disclosure," or any assertion which is contradictory to assertions made to the Examiner during prosecution of the present application.

To this end, Applicants submit to the Examiner in the present Information Disclosure Statement various prior art that arose in connection with the above-identified litigations. Applicants also wish to make of record in the present application the following documents from the litigations:

- A. Case No. 6:02-cv-270-ORL-19JGG
 - 1. Plaintiff's Amended Verified Complaint
 - 2. Defendant's Answer and Counterclaims

3. Plaintiff's Answer to Counterclaims
4. Plaintiff's Answers to Defendant's First Set of Interrogatories

Three exhibits originally accompanied document 4 above: Exhibit 1, which is an affidavit of Kevin Furry and Chuck Somerville; Exhibit 2, which is a confidential financial statement furnished by the Plaintiff; and Exhibit 3, which is a confidential opinion of counsel obtained by the Plaintiff relating to validity and non-infringement of the asserted patents. Exhibit 1 is cited herein (and appears on the accompanying PTO Form-1449). Both Exhibits 2 and 3 accompanying document 4 were marked "Confidential," pursuant to a Confidentiality Agreement between the parties in the Florida case, and hence have not been disclosed to the United States Patent and Trademark Office.

B. Case No. 02 CV 11137MEL

1. Plaintiff's Complaint and Jury Demand
2. Defendant's Answer and Affirmative Defenses

Applicants make no representation that the documents identified herein relating to these litigations provide information material to the examination of the present application. Applicants make these documents of record in the present application primarily for completeness to facilitate the Examiner's understanding of the nature of these litigations. The Examiner is urged to form his or her own conclusion regarding the relevance of the information contained in these documents.

PART III: Explanation of Non-English Language References

The following is a concise explanation of the relevance of each non-English language reference listed on the attached form PTO-1449 (modified):

Some of the references listed on the attached form PTO-1449 (modified) were cited in at least one of five oppositions filed against a European counterpart to U.S. Patent No. 6,016,038 (U.S. Serial No. 08/920,156), discussed above in Part II. The European counterpart is EP Patent

No. 1,016,062, EP Serial No. 98944539.0. Again, the present application, like U.S. Serial No. 08/920,146, currently is assigned to Color Kinetics, Inc., and incorporates by reference the entirety of U.S. Serial no. 08/920,156.

Applicants make no representation that the documents cited herein relating to the European oppositions provide information material to the examination of the present application. Applicants make these documents of record in the present application primarily for completeness to facilitate the Examiner's understanding of the nature of these oppositions. The Examiner is urged to form his or her own conclusion regarding the relevance of the information contained in these documents.

PART IV: Remarks

Documents cited anywhere in the Information Disclosure Statement are enclosed unless otherwise indicated. It is respectfully requested that:

1. The Examiner consider completely the cited information, along with any other information, in reaching a determination concerning the patentability of the present claims;
2. The enclosed form PTO-1449 be signed by the Examiner to evidence that the cited information has been fully considered by the Patent and Trademark Office during the examination of this application;
3. The citations for the information be printed on any patent which issues from this application.

By submitting this Information Disclosure Statement, the Applicant makes no representation that a search has been performed, of the extent of any search performed, or that more relevant information does not exist.

By submitting this Information Disclosure Statement, the Applicant makes no representation that the information cited in the Statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

Serial No.: 09/716,819
Conf. No.: 9031

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Art Unit: 2875
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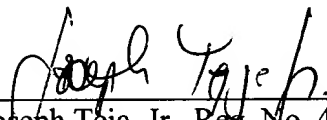
By submitting this Information Disclosure Statement, the Applicant makes no representation that the information cited in the Statement is, or is considered to be, in fact, prior art as defined by 35 U.S.C. §102.

Notwithstanding any statements by the Applicant, the Examiner is urged to form his own conclusion regarding the relevance of the cited information.

An early and favorable action is hereby requested.

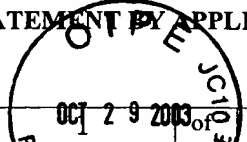
Respectfully submitted,

Alfred D. Ducharme, et al., Applicants



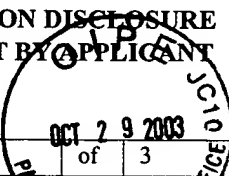
Joseph Teja, Jr., Reg. No. 45,157
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Attorney for Applicants

Attorney Docket No.: C1104/7061
Dated: October 27, 2003

FORM PTO-1449/A and B (Modified)		APPLICATION NO.: 09/716,819	ATTY. DOCKET NO.: C1104/7061
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		APPLICANT: Alfred D. Ducharme, et al.	
		GROUP ART UNIT: 2875	EXAMINER: Lee, Y. My Quach
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U.S. PATENT DOCUMENTS

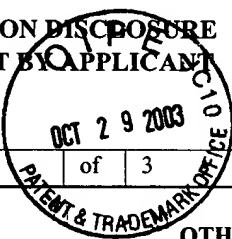
Examiner's Initials	Cite No.	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication or of issue of Cited Document MM-DD-YYYY
		Number	Kind Code		
		4,271,408		Teshima, et al.	06/02/1981
		4,339,788		White et al.	07/13/1982
		4,342,947		Bloyd	08/03/1982
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		5,907,742		Johnson et al.	05/25/1999
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FORM PTO-1449/A and B (Modified)		APPLICATION NO.: 09/716,819	ATTY. DOCKET NO.: C1104/7061
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		GROUP ART UNIT: 2875	EXAMINER: Lee, Y. My Quach
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FOREIGN PATENT DOCUMENTS

Examiner's Initials	Cite No.	Foreign Patent Document			Name of Patentee or Applicant of Cited Document (not necessary)	Date of Publication of Cited Document MM-DD-YYYY	Translation (Y/N)
		Office/ Country	Number	Kind Code			
		GB	2131589	A	Integrated Systems Engineering, Inc.	11/04/1982	
		GB	2210720	A	Eric Cheng	06/14/1989	
		CA	2134848		Vari-Lite, Inc.	11/24/1998	
		EP	1162400	A2	Omnilux s.r.l.	12/12/2001	
		DE	9414689		Schlumer, Heinz-Dieter	02/02/1995	No
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		JP	6 43830		NEC Corp.	02/18/1994	Yes
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		DE	4041338	A1	Bayerische Motoren Werke AG	07/01/1992	Abstract
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		DE	19651140	A1	Loptique Ges Fuer Lichtsysteme	06/19/1997	Abstract
		DE	3925767	A1	Siemens AG	04/26/1990	Abstract
		DE	2315709		Licentia Patent-Verwaltungs	10/10/1974	No
		DE	3438154	A1	SWF Auto Electric GmbH	04/24/1986	Abstract
		EP	482680	A1	N.V. Phillips	04/29/1992	
		EP	734082	A2	Motorola, Inc.	09/25/1996	
		DE	9414688	U1	Schlumer, Heinz-Dieter	02/02/1995	No

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		GROUP ART UNIT: 2875	EXAMINER: Lee, Y. My Quach
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OTHER ART — NON PATENT LITERATURE DOCUMENTS

Examiner's Initials	Cite No	Include name of the author (in CAPITAL LETTERS) title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, relevant page(s), volume-issue number(s), publisher, city and/or country where published.	Translation (Y/N)
		Hewlett Packard Components, "Solid State Display and Optoelectronics Designer's Catalog," pp. 30-43, July 1973	
		INTEC Research, TRACKSPOT, http://www.intec-research.com/trackspot.htm , pp. 1-4, April 24, 2003.	
		SHARP, Optoelectronics Data Book, pp. 1096-1097, 1994/1995	
		About DMX-512 Lighting Protocol – Pangolin Laser Systems, pp. 1-4, April 7, 2003	
		Avitec Licht Design '89-90, pp. 1-4	No
		Dr. Ing, Ulrich Tietze, Dr. Ing, Christoph Schenk, pp. 566-569	No
		FURRY, Kevin and SOMERVILLE, Chuck, Affidavit, LED effects, February 22, 2002, pp. 24-29.	
		PUTMAN, Peter H., "The Allure of LED," www.sromagazine.biz , June/July 2002, pp. 47-52.	
		BREMER, Darlene, "LED Advancements Increase Potential," www.ecmag.com , April 2002, p. 115.	
		LONGO, Linda, "LEDs Lead the Way," Home Lighting & Accessories, June 2002, pp. 226-234.	
		Case No. 6:02-cv-270-ORL-19JGG in the United States District Court, Middle District of Florida, Orlando Division, Plaintiff's Amended Verified Complaint	
		Case No. 6:02-cv-270-ORL-19JGG in the United States District Court, Middle District of Florida, Orlando Division, Defendant's Answer and Counterclaims	
		Case No. 6:02-cv-270-ORL-19JGG in the United States District Court, Middle District of Florida, Orlando Division, Plaintiff's Answer to Counterclaims	
		Case No. 6:02-cv-270-ORL-19JGG in the United States District Court, Middle District of Florida, Orlando Division, Plaintiff's Answers to Defendant's First Set of Interrogatories w/Exhibit 1	
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		Case No. 02 CV 11137MEL in the United States District Court, District of Massachusetts, Defendant's Answer and Affirmative Defenses	
EXAMINER		DATE CONSIDERED	

#EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[NOTE - Must provide a copy of any patent, publication, other information listed, even if it was previously submitted to, or cited by, the U.S. Patent Office in an earlier application, unless the earlier application is identified by the IDS and is relied upon for an earlier filing date under 35 U.S.C. §120, and the copy was provided in the earlier application.]